



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

13826

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]
on _____

Signature _____

Typed or printed

Name _____

Application Number

09/991,953

Filed

November 26, 2001

First Named Inventor

Tosiyasu L. KUNII

Art Unit

3627

Examiner

Michael A. CUFF

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

Signature

I am the

- applicant/inventor.
- assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- attorney or agent of record.
Registration number 28,868
- attorney or agent acting under 37 CFR 1.34.
Registration number _____

Ralph A. Dowell

Typed or printed name

703.415.2555

Telephone number

Date

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:) Confirmation No.: 5231
Tosiyasu L. KUNII) Group Art Unit: 3627
Serial No.: 09/991,953) Examiner: Michael A. CUFF
Filed: November 26, 2001) Attorney Docket: 13826
For: ELECTRONIC COMMERCIAL...) Customer No. 001059

Mail Stop AF,
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
U.S.A.

PRE-APPEAL BRIEF

In response to the Final Office Action mailed April 19, 2007, the Applicant hereby submits a Pre-Appeal Brief for consideration. Claims 6-17 and 23-25 are pending in this application. Claims 6-17 and 23-25 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Bowman (6,169,986) in view of either Ng (6,405,175) or in view of Ng (6,405,175) in further view of Bauer (5,926,816).

The Applicant respectfully submits that the Examiner has failed to establish a *prima facie* basis for rejection of claims 6-17 and 23-25 under §103(a). To establish a *prima facie* case of obviousness, MPEP §2143 requires that three criteria must be met. First, there must be some suggestion or motivation, either in the prior art references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all of the claimed limitations. In particular, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art": *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) (emphasis added). The Applicant submits that, at least, the cited references do not teach or suggest all of the claimed limitations of claims 6 and 23, and accordingly, the Examiner has not established a *prima facie* case of obviousness.

The Examiner suggests that Bowman describes "all the elements of claim 6-14, 23 and 24 except for specifying the use of the search system with a group of stores in an e-mail" (Final Office Action, page 2). After this statement, the Examiner recites several portions of the Bowman specification, but the Examiner does not clearly state how those portions relate to all the elements in the rejected claims except the "stores in an e-mail". The Applicant has reviewed the Office Action and the references in detail and submits that the references do not teach or suggest all the elements of the claims. Referring in particular to claim 23, the Applicant submits that the references do not teach or suggest at least the elements of:

determining if any attributes of the first search attributes did not previously exist in the attribute correspondence table, and for each such attribute:

defining such attribute as a new attribute, and

recording at least one new correspondence relationship between the new attribute and a product attribute that is associated with the first product in the attribute correspondence table

Applicant submits that recording the new correspondence relationship with the product allows that product to be returned in a subsequent search that uses the new attribute (para. 147-148). Applicant submits there is nothing in Bowman (or the other references) that teaches or suggests this element or provides for this functionality.

In Bowman, a user submits a query to search a bibliographic database for products and items (col. 6 lines 22-30). Based on query terms within that query, Bowman suggests related terms to refine that query (col. 6, lines 47-52). Bowman stores the related terms within entries of a correlation data structure, such as a correlation table (col. 2, lines 48-51). Each entry of the correlation table has "a key term and a corresponding related terms list" (col. 2, lines 65-67). "Each related terms list contains the terms which have historically appeared together (in the same query) with the respective key term" (col. 2, line 67 to col. 3 line 2). Related terms may receive a correlation score based on factors such as the

frequency of use with the key term (col. 10, lines 48-56) and whether the search resulted in additional actions, such as a purchase (col. 11, lines 35-49). Applicant submits that this approach relates search terms to other search terms and ranks the frequencies of the related search terms, but does not determine if any search terms are new attributes for a product and does not newly associate any search terms with an attribute of a particular product.

The Examiner states that Bowman discloses "a system and method for refining search queries" (Final Office Action, page 2). However, refining a search query is distinctly different from recording a new correspondence relationship between a new attribute and a product. In particular, refining a search only adds new terms to the search query. The use of the new terms will still only return products in the bibliographic database that already have some relation to the new search terms. In contrast, recording a new correspondence relationship between a new attribute and a product can allow a subsequent search using the new attribute to return a product that would not have otherwise been returned.

Bowman utilizes a bibliographic database, a query log and a correlation table. Applicant submits that none of these elements is used in the recording of new correspondence relationships and new attributes for products. In particular, the bibliographic database represents the information that is searched and "includes information about various products that users may purchase through [a] website" (col. 5, lines 42-54). However, Bowman never describes updating the bibliographic database for a particular product with any new information generated by searches, let alone information pertaining to correspondence relationships or new attributes. The query log is merely a log of the queries made in a given time period (col. 5, lines 35-39). Referring to the correlation table, Bowman only describes the entries of the correlation table as having a key term and a related terms list. While Bowman may describe updating the correlation table (col. 8, lines 40-57 and col. 12, lines 33-42), Bowman never describes the correlation table as containing information about specific products, let alone how terms or attributes relate to

products. Even if Bowman records new correspondence relationships in the correlation table, which is not admitted, the correspondence relationships therein would be between search terms and other search terms, and NOT between attributes and a product.

The Examiner refers to column 11, lines 35-44 of Bowman as showing the detection of a purchase of a suggested product. While this may be the case, it is clear that any detection of a purchase in Bowman is used for the purpose of adjusting the calculation of a correlation score as between a search term and another search term (col. 11, lines 45-49). Accordingly, the detection of a purchase in Bowman does NOT relate to adding a new correspondence relation between a new attribute and a product attribute as in the present application and claims.

The Examiner relies on Ng as merely teaching a system of e-mails sharing resources in an e-mail. Applicant submits that Ng does not provide any additional teaching or suggestion with regard to at least the elements discussed above.

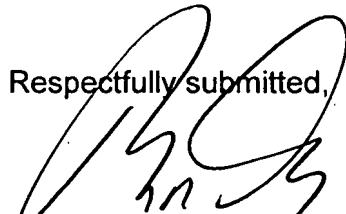
Accordingly, the Applicant submits that neither Bowman nor Ng nor the combination thereof teach or suggest all of the elements in independent claim 23.

The Applicant further submits that, in at least one respect, Bowman in fact teaches away from the system and method of the present application. Bowman attempts to solve the problem where a user receives a large number of query results, which "requires the user to read through many other items in the query result before reaching the sought item" (col. 1, lines 48-55). In contrast, relating new attributes to products can actually expand the scope of the results of a search query.

Accordingly, the Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness, and that independent claim 23 is in condition for allowance. For at least similar reasons, independent claim 6 is also submitted to be in condition for

allowance. Furthermore, Applicant submits that the cited references do not teach or suggest "a reflexive law, a symmetric law and a transitive law" as recited in claim 6. Nor do the cited references teach or suggest "a cellular decomposition operation" as recited in claim 6. Nor do the cited references teach or suggest "decomposing a set of attributes into nonempty disjoint equivalence classes according to [an] equivalence relation" as recited in claim 6. For at least these additional reasons, Applicant submits the Examiner has failed to establish a *prima facie* case of obviousness and that claim 6 is in condition for allowance. Claims 7-17 and 24-25 depend from claims 6 and 23, and for that reason, as well as for the additional elements included therein, are also believed to be in condition for allowance (*In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

In light of the above comments, the Applicant submits that the application is in condition for allowance.

Respectfully submitted,


USPTO Customer No. 000293
Ralph A. Dowell
Registration No. 26,868

Dowell & Dowell, P.C.
2111 Eisenhower Avenue, Suite 406
Alexandria, Virginia 22314, U.S.A.
Telephone (703) 415-2555
Facsimile (703) 415-2559

Date: July 19, 2007
NH/pc
B&P Ref.: 14362-7